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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 190252-1890

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Typed or printed name Brooke French

Application Number	Filed
09/886,071	6/20/01

First Named Inventor: Topfl, et al

Art Unit	Examiner
2152	Chankong, Dohm

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 34,367
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Jeffrey R. Kuester
Typed or printed name

(770) 933-9500
Telephone number

March 13, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[X] *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Topfl, *et al.*	
Serial No.: 09/886,071	Group Art Unit: 2152
Filed: June 20, 2001	Examiner: Chankong, Dohm
For: System and Method for Server-Based Predictive Caching of Back-End System Data	Docket No.: 190252-1890

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief Conference.

REMARKS

Claims 1, 2, 6, 7, 11, and 12 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Jiang, et al* (U.S. Patent No. 6,385,641) in view of *Pirolli, et al* (U.S. Patent No. 6,098,064) in further view of *Adar, et al* (U.S. Patent No. 6,493,702). Claims 3-5, 8-10, and 13-16 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Jiang, et al* (U.S. Patent No. 6,385,641), *Pirolli, et al* (U.S. Patent No. 6,098,064), *Adar, et al* (U.S. Patent No. 6,493,702) in view of *Barrett, et al* (U.S. Patent No. 5,727,129). Applicant traverses these rejections and respectfully submits that the rejections of record are clearly not proper.

Specifically, Applicant respectfully submits that the following clear legal deficiency exists in the rejection. In the previous Response, Applicant argued that *Pirolli* teaches away from the claims, specifically the claim language of "calculating a probability ... of a particular user." In support of this argument, Applicant demonstrated that the *Pirolli* system "compute[s] a collective context Q for a community of client computers as opposed to an individual context Q for a single computer." See *Pirolli*, col. 11, lines 22-26. In the Advisory Action, the Examiner claimed that "*Pirolli* does not expressly teach away from Jiang." However, in this case, the controlling factor is whether the reference teaches away from the claims, not whether it teaches away from another reference. The fact that *Pirolli* may not teach away from another reference is immaterial to a determination of whether it teaches away from the claims. Since it teaches away from "calculating a probability ... of a particular user" as claimed, its use in a combination is improper.

The Examiner asserted that the claim language can be interpreted broader than Applicant has argued. He states that there is nothing in the claim language that mandates that the probability be calculated based solely on the user's actions. Claim 6, as one example, states, "calculating a probability for the links associated with the successive actions of the authenticated particular user." This statement provides that the probability is calculated based on the successive actions of the authenticated particular user.

The Examiner also added that "nothing in the claim language is directed towards how the desirability is to be calculated for the particular user." Applicant respectfully submits that the method that is used to calculate the probability is immaterial to the claim as long as it is calculated for a particular user and is associated with the successive actions of that particular user.

Since *Pirolli* clearly teaches away from the claims, its use as a reference is improper, and the rejections using the *Pirolli* reference should be withdrawn. Additionally, when the *Pirolli* reference is removed from consideration, the application will revert to non-final status.

The Office Action further finds that at least one feature in the claims is well-known in the art. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." Applicant further respectfully submits that a singular patent, such as the *Pirolli* patent, is not sufficient evidence in and of itself to establish a conclusion that a feature is well-known. As the cited features have not been shown capable of such instant and unquestionable demonstration as to deny dispute, the finding that the features are "well-known" is improper and the claims should be allowed.

PAGE 7/8 * RCVD AT 3/13/2006 3:50:39 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/11 * DNIS:2738300 * CSID:14047950814 * DURATION (mm-ss):04-30

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-16 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.

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